

surrendered, the alleged surrendered matter must be found in claims that did not issue, that is claims as they existed before cancellation or amendment.

As stated in *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997), "deliberately canceling or amending a claim in an effort to overcome a reference strongly suggests that the applicant admits that the scope of the claim before the cancellation or amendment is unpatentable" (emphasis added). The term "amended claim" in the cases cited in the Office Action refers to a claim as it appeared before amendment. Claims 15-18 of the present application are not broader in scope than any cancelled or amended claim. Original claims 1 and 9 of Application Serial No. 08/690,045 did not contain a limitation to fibers spaced apart by a flexible support means. In fact, no cancelled or amended claim of Application Serial No. 08/690,045 referred to fibers spaced apart by a flexible support means. Accordingly, claims 15-18 of the present application do not attempt to recapture surrendered subject matter because the element of fibers spaced apart by a flexible support means was not present in any cancelled or amended claims.

The applicants respectfully submit that the Office Action also fails to recognize that claims 15-18 of the present application have been materially narrowed compared to the cancelled or amended claims. Claims which have been materially narrowed so as to have a different scope from cancelled claims do not constitute recapture. *In re Wadlinger* 496 F.2d 1205-1206, 181 USPQ 830-831. As stated in *In re Hester*, "this principle, in appropriate cases, may continue to overcome the recapture rule when the reissued claims are materially narrower in other overlooked aspects of the invention. The purpose of this exception to the recapture rule is to allow the patentee to obtain through reissue a scope of protection to which he is rightfully entitled for such overlooked aspects." Claims 15-18 of the present application are narrower than any cancelled or amended claim in the following aspects:

1. Claim 15 recites an entire system containing a non-pressurized reservoir and a pump in fluid communication with the lumens of the membranes and operable to apply suction to the lumens to withdraw permeate.
2. The aeration means of claim 15 has through passages with openings distributed both radially and circumferentially within the skein for discharging air directly into the substrate near the base of the skein.
3. Dependent claim 16 further restricts the length of the fibers and is narrower in that aspect than any original claim of Application No. 08/690,045.
4. Dependent claim 17 recites that aeration means including a rigid air supply tube for carrying air to the through passages and for spacing the positioning the lower and upper headers relative to one another.

5. Dependent claim 18 recites that the air supply tube has additional through passages along its length.


None of the limitations listed above were present in any cancelled or amended claim of original Application No. 08/690,045.

In summary, the applicants submit that the Office Action fails to point to any subject matter that was surrendered in original Application No. 08/690,045 that is recaptured by present claims 15-18. Applicants further submit that the Office Action errs in suggesting that present claims 15-18 are only narrower in that they recite a pump, when they are actually materially narrower in previously overlooked aspects of the invention.

The applicants submit that this application is in condition for allowance.

Respectfully submitted,

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